

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the above amendments and following remarks and discussion is respectfully requested.

Claims 1-95 are pending; Claims 4-23, 27-46, 50-69 and 73-92 are withdrawn from consideration; Claims 1, 24, 47, 70, and 95 are amended; Claim 96 is canceled; and no claims are added herewith. It is respectfully submitted that no new matter is added by this amendment.

The Office Action rejects Claims 1, 24, 47 and 70 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,559,604 to Arai; Claims 2-3, 25-26, 48-49, 71-72, 93-94 and 95-96 are rejected under 35 U.S.C. § 103(a) as unpatentable over Arai in view of well known prior art; and Claims 47-49 are rejected under 35 U.S.C. § 101.

The independent claims recite, in part, recording data representative of the image with data representative of the estimated illuminant and transmitting the data representative of the image with the data representative of the estimated illuminant.

Arai discloses an apparatus that can reproduce the color under an arbitrary illuminant, i.e. under not only a standard illuminant but also a different illuminant other than the standard illuminant. A multilayered feedforward neural network is used as the transforming means. Additionally, as the predetermined illuminant, it is possible to use a standard illuminant of a D illuminant.

The color converting means is constituted by a multilayered feedforward neural network that is adjusted such that the color transformation processing for transforming colorimetric values into color separation values can be effected accurately when the color temperatures of all the illuminants, which are estimated as illumination at the time of observation, are inputted in advance, including a predetermined illuminant such as a standard

illuminant, an A illuminant, a B illuminant, a C illuminant, and fluorescent-lamp illuminants such as F1 to F12.

As acknowledged in the outstanding Office Action, Arai does not disclose recording or transmitting the data representative of the color image with the data representative of the estimated illuminant.

When an obviousness determination is based on multiple prior art references, there must be a showing by the patent examiner of some “teaching, suggestion, or reason” to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”). Whether motivation to combine the references is shown is a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, *inter alia*, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. “Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.” Winner International Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). Interpreting the Supreme Court’s decision in Dickinson v. Zurko, 50 USPQ2d 1930 (1999) regarding the standard of review in patent matters, the CAFC determined that when upholding a rejection of a claimed invention in an appeal, the CAFC must find that the decision by the USPTO Board of Appeals and Interferences is supported by

“substantial evidence,” In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000). Accordingly, for a proper rejection based on a combination of references, the rejection must be supported by evidence that the motivation to combine references was not merely feasible, but desirable.

It is respectfully submitted that there is no basis in the teaching of Arai to support the asserted modification of Arai. Certainly, the outstanding Office Action fails to cite any specific teachings within Arai to provide motivation for the modification of Arai. Accordingly, it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 based on Arai is the result of hindsight reconstruction of the reference in view of the present specification, and is improper.

Thus, for at least the above reasons, Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 102 and § 103 be withdrawn.

Consequently, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. A Notice of Allowance for the pending claims is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073

Kevin M. McKinley  
Registration No. 43,794

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

BDL:KMM\la  
I:\ATTY\KMM\PROSECUTION WORK\203808\203808US-AM.DOC